

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Torres, M.

Art Unit: 2683

In re:

Applicant: WEIDNER, W., et al

Serial No.: 09/367,569

Filed: December 21, 1999

REQUEST FOR RECONSIDERATION

June 1, 2007

Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is responsive to the Office Action of March
7, 2007.

In the Office Action the Examiner indicated that claims 19-20 were unpatentable under 35 U.S.C. 103(a) over the reference to Tsoi in view of the reference to Baals.

After carefully considering the Examiner's grounds for the rejection of the claims, applicants retained the claims as they were.

Before the analysis of the prior art, it is believed to be advisable to explain to the Examiner the present invention and to emphasize the new features as defined in the claims.

Claim 19 defines the following features:

- Two control elements having local association to displayed function on a display device (1)
- First control element is associated in a first operating state with an information displayed on the device about the first operating state (2), the first control element having no function (3)

- Second control element is associated in the first operating state with a function displayed on the device for activating a second operating state (4)
- first and second operating states are associated with each other (5)
- first control element is associated with a function for activating the first operating state in the second operating state (6).

The Examiner cited the patent to Tsoi as disclosing the features 1, 2, and 4-6, especially column 6, line 62, to column 7, line 7 and Figures 7-13.

In order to compare the solution proposed in the Tsoi with the present invention, it is necessary first of all to define which elements and which operating states represent the first and second elements and states as defined in the present application.

According to the above text passage Tsoi provides a device having two displays operating state. By pressing the key 82, the user terminates a call. In the second display 74 information ("in connection") is displayed in the first operating state (figure 8). The second operating state

may be the situation shown in Figure 9 (col. 7, lines 1 to 6). In this operating state key 82 is associated with the same function (“hang up”), further control elements are associated with other functions (no information or function associated with these keys in the first operating state. On display 74 information (“connected”) is shown.

The comparison of the teaching of the Tsoi reference with the new features of applicant’s invention, the following conclusions can be made:

The patent to Tsoi shows:

- two control elements (see figure 9) having local association to displayed function on a display device
- a second control element (see key 82) is associated in the first operating state (see figure 8) with a function (see “hang up”) displayed on the device for activating a second operating state (see figure 9)
- the first and second operating states are somehow associated with each other.

The patent to Tsoi does not show:

- a first control element is associated in a first operating state with an information displayed on the device about the first operating state (2), the first control element having no function
- first control element is associated with a function for activating the first operating state in the second operating state

It is therefore respectfully submitted that the main new feature of the present invention as defined in claim 19 are not disclosed in the patent to Tsoi.

The Examiner cited the Baals reference for the feature of a control element having no function and to which merely the information about a first operating state is assigned. Reference is made to figure 6 of Baals. It might be correct that displayed information (210-6) is information, but this information is not assigned to one of the control elements (214 to 229).

Therefore the patent to Baals does not show the above core feature, especially the change from pure information to a function associated

with the first control element when the operating state are switched (feature (6)) is not shown.

As for the combinations of the references proposed by the Examiner, it is respectfully submitted that any hypothetical combination of the Tsoi reference and the Baal reference would not lead a person skilled in the art to the applicant's invention as defined in claim 19, since the references do not have any hint or suggestion taken singly or in combination with one another to have a first control element associated in a first operating state with an information displayed on the device about the first operating state, the first control element having no functions, the first control element is associated with a function for activating the first operating state in the second operating state.

The Examiner rejected the original claims over the combination of the references as being obvious in the sense of 35 U.S.C. 103. It is believed to be clear that the combination of the references would not lead to the applicant's invention as defined in claim 19. In order to arrive at the applicant's invention from the combination of the references, the references have to be fundamentally modified by including into them the above

mentioned new features of the present invention which are not disclosed in them and were first proposed by the applicant's.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented considerations, it is believed that claim 19 should be considered as patentably distinguishing over the art and should be allowed, together with claim 20 which depends on it.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance,

then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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